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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/094,030	06/09/1998	PIERRE DUPUY	Q50496	7914

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EXAMINER
LOGSDON, JOSEPH B
ART UNIT
PAPER NUMBER

2662

DATE MAILED: 01/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/094,030

Applicant(s)

DUPUY, PIERRE

Examiner

Joe Logsdon

Art Unit

2662

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Objections:

1. Claim 1 is objected to because "the following association period" should be replaced with - the following allocation period- -. Claims 2-5 depend on claim 1 and are therefore similarly objected to. Appropriate correction is required.

Claim Rejections—35 U.S.C. 112, First Paragraph:

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 1, 6, and 7 recite "consecutive transmission channels identifiable from said authorization channel using a predefined relationship, *are* allocated in the up direction for the following allocation period" [emphasis added]. But the specification fails to provide any detail on how one might derive a "predefined relationship" for consecutive channels that are actually allocated. Instead, the specification teaches that the consecutive channels *can be* allocated for the next transmission period (page 7, lines 9-31). A predefined relationship is not used to actually assign the channels. According to the specification, "The choice of the number of time slots allocated to the mobile station for transmission... is made by the network... *as a function of the transmission*

Art Unit: 2662

needs of the network... [S]aid authorization channel is displaced *as a function of* the quantity of data to be transmitted by the mobile station... In addition, the number of transmission channels allocated for reception is reduced when the number of said consecutive channels is increased, so as to retain a guard time that is *long enough* between reception and transmission, thereby making half-duplex mode operation possible” [emphasis added] (page 9, lines 20-37). The consecutive channels actually used for the transmission by the mobile station are therefore not redefined. The specification therefore fails to enable one of ordinary skill in the art to make or use the invention as claimed. Claims 2-5 depend on claim 1 and are therefore similarly rejected.

Claims 1, 6, and 7, further depend on a “controller” which, as mentioned in claims 6 and 7, enables the method to operate. The specification provides no enabling detail on how to make or use such a controller. Figures 3 and 4 simply depict the controller as a rectangle. For example, no description is provided for how the “controller” within a mobile station determines which of the channels (time slots) within a window should actually be allocated to the mobile station. The specification does not describe the manner in which the “controller” within the base station arbitrates between the mobile stations. The specification therefore fails to enable one of ordinary skill in the art to make or use the invention as claimed. Claims 2-5 depend on claim 1 and are therefore similarly rejected.

Claim Rejections—35 U.S.C. 112, Second Paragraph:

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

Claim 1 is a method claim, yet claim 1 contains no steps. For example, “a transmission authorization received over a transmission channel” is not a step because it does not indicate that such a transmission authorization is indeed received. Claim 2-5 depend on claim 1 and are therefore similarly rejected.

Claims 1, 6, and 7 recite “consecutive transmission channels identifiable from said authorization channel using a predefined relationship, *are* allocated in the up direction for the following allocation period” [emphasis added]. But the specification fails to provide any detail on how one might derive a “predefined relationship” for consecutive channels that are actually allocated. Instead, the specification teaches that the consecutive channels *can be* allocated for the next transmission period (page 7, lines 9-31). A predefined relationship is not used to actually assign the channels. According to the specification, “The choice of the number of time slots allocated to the mobile station for transmission... is made by the network... *as a function of the transmission needs* of the network... [S]aid authorization channel is displaced *as a function of* the quantity of data to be transmitted by the mobile station... In addition, the number of transmission channels allocated for reception is reduced when the number of said consecutive channels is increased, so as to retain a guard time that is *long enough* between reception and transmission, thereby making half-duplex mode operation possible” [emphasis added] (page 9, lines 20-37). The consecutive channels actually used for the transmission by the mobile station are therefore not redefined. Claims 2-5 depend on claim 1 and are therefore similarly rejected.

Claim Rejections—35 U.S.C. 102(a):

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 1, 2, 6, and 7 are rejected under 35 U.S.C. 102(a) as being anticipated by the Admitted Prior Art.

With regard to claim 1, 6, and 7, the Admitted Prior Art teaches a method of allocating time slots to a mobile station in half-duplex mode in a mobile telecommunications data packet network, in which multiple access is implemented through multiplexing of time slots, and a mobile and base station that together implement the method (page 1, line 34 to page 2, line 37). A time slot is a transmission channel. The method comprises the steps of receiving a transmission authorization in a time slot in the down direction for a given frame, which indicates that the same time slot is allocated in the up direction for the following frame (page 2, lines 20-27). When GPRS is used, the time slots allocated to a mobile station for the duration of a call can change from one frame to another (page 2, lines 18-20). A frame is therefore an allocation period. A transmission authorization channel received in a time slot in the down direction for a given frame indicates that not only the time slot, but also consecutive time slots identifiable from the time slot using a predefined relationship (wherein the number of such consecutive time slots is zero), are allocated in the up direction for the following frame (page 2, lines 20-27).

Art Unit: 2662

Interpreting “consecutive time slots identifiable from the time slot using a predefined relationship” to include the possibility that the number of such consecutive time slots is zero is consistent with the fifth example described in the specification (page 8, line 31 to page 9, line 13).

With regard to claim 2, the Admitted Prior Art inherently teaches a window of width equal to one time slot (page 2, lines 20-27) because only one time slot is allocated to the mobile station for transmission.

Response to Arguments:

8. Applicant’s arguments concerning the prior art rejections are moot in view of the new grounds of rejection.

In general, Applicant argues that terms such as “predefined relationship,” “function,” and “long enough” are well known in the art and therefore cannot serve as a basis for an enablement rejection. But it is not the terms themselves that are relevant; instead, it is only the concepts underlying those terms that are relevant. In various contexts, the meaning of these terms may be well known, but this does not imply that they are well known as applied to the claimed invention. For example, if one of ordinary skill in the art already knows how to allocate uplink transmission channels based on the authorization channel using a “predefined relationship,” then much of the claimed invention would have been obvious to one of ordinary skill in the art.

The term “predefined relationship,” as well as the other terms, are, however, adequately defined in the specification via examples. Nevertheless, the use of the term “predefined

Art Unit: 2662

relationship” in the claims contradicts its use in the specification, as pointed out in this Office Action.

Applicant argues that one of ordinary skill in the art would know how to make and use a conventional controller. But the issue is not whether one of ordinary skill in the art would know how to make and use a *conventional* controller, but whether one of ordinary skill in the art would know how to make and use the controller *that implements the claimed invention*. Furthermore, it is, again, not the term “controller” that is relevant, but only the concept intended for “controller” that matters. Any system in any art requires a “controller”; one cannot conclude from this that everyone understands the meaning of “controller,” as recited in the claims.

Applicant further argues that because the specification states in effect that the controller is enabled, Examiner must conclude that the controller is enabled. The issue is not, however, whether the specification states that the controller is enabled, but whether the specification in fact enables the controller.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Logsdon whose telephone number is (703) 305-2419. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Hassan Kizou, can be reached at (703) 305-4744.

Art Unit: 2662

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

10. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to:

(703) 872-9314


For informal or draft communications, please label "PROPOSED" or "DRAFT".

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA, Sixth Floor (Receptionist).

Joe Logsdon

Patent Examiner

Monday, January 14, 2002


HASSAN KIZOO
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